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DUKE W. YEE YEE AND ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380			FEARER, MARK D	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG WILLIAM FELLENSTEIN,
CARL PHILLIP GUSLER, RICK ALLEN HEMILTON II,
and JAMES WESLEY SEAMAN

Appeal 2009-006595
Application 10/626,194
Technology Center 2400

Before JAMES D. THOMAS, ST. JOHN COURtenay III, and
JAMES R. HUGHES, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 27. We have jurisdiction under 35 U.S.C. § 6(b).

We vacate the rejection under 35 U.S.C. § 103 before us and institute a new ground of rejection within the provisions of 37 C. F. R. § 41.50(b).

Invention

An apparatus and method for facilitating communication through a messaging system by identifying times when a user of the system is most likely to be available for a messaging session. The apparatus comprises an event monitor, a database, a usage processor, and a usage indicator. The event monitor detects messaging system events and records information about these events in the database. The usage processor retrieves the recorded information from the database and uses the information to compile[s] statistical usage data for a given user. The usage indicator then displays the statistical usage data in a summary format to an end user. In the preferred embodiment, the event monitor, usage processor, and usage indicators are all implemented as computer instructions. These three components may be executed independently of each other, or they may be integrated into a single computer program. Similarly, each component may operate independently or be integrated into an existing messaging system.

(Spec. 14, ll.4-14, Figs.3 & 5.)

Representative Claim

21. A method of identifying optimal times for an end user to contact a target user of a messaging system, comprising detecting messaging system events, recording the messaging

system events in a database, compiling statistical usage data from the messaging system events, and displaying the target user's statistical usage data on an output device; wherein the statistical usage data is adapted to allow the end user to determine a best time to contact the target user for a messaging session by providing a plurality of data regarding the target user's times for signing in and signing out, the target user's average time signed on each day, and the target user's messages sent and received.

Prior Art and Examiner's Rejection

The Examiner relies on the following references as evidence of unpatentability:

Monza	US 2004/0081183 A1	Apr. 29, 2004 (filed May 15, 2003)
Matsliach	US 6,879,994 B1	Apr. 12, 2005 (filed Jan. 4, 2000)
Tamir	US 6,957,390 B2	Oct. 18, 2005 (filed Nov. 30, 2000)

All claims on appeal, claims 1 through 27, stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner relies upon Matsliach in view of the Monza and Tamir.

ANALYSIS

We vacate the prior art rejection encompassing all claims on appeal because we conclude that all claims on appeal, claims 1 through 27, are “barred at the threshold by § 101.” *In re Comiskey*, 554 F.3d 967, 973 (Fed.

Cir. 2009) (citing *Diamond v. Diehr*, 450 U.S. 175, 188 (1981)). Therefore, the following new ground of rejection is set forth in this Opinion within the provisions of 37 C.F.R. § 41.50(b).

NEW REJECTION UNDER 35 U.S.C. § 101

PRINCIPLES OF LAW

Statutory Subject Matter

The subject matter of claims permitted within 35 U.S.C. § 101 must be a machine, a manufacture, a process, or a composition of matter. Moreover, our reviewing court has stated that “[t]he four categories [of § 101] together describe the exclusive reach of patentable subject matter. If the claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007); *accord In re Ferguson*, 558 F.3d 1359 (Fed. Cir. 2009). This latter case held that claims directed to a “paradigm” are nonstatutory under 35 U.S.C. § 101 as representing an abstract idea. Thus, a “signal” cannot be patentable subject matter because it is not within any of the four categories. *In re Nuijten*, 500 F.3d at 1357. Laws of nature, abstract ideas, and natural phenomena are excluded from patent protection. *Diamond v. Diehr*, 450 U.S. at 185. A claim that recites no more than software, logic or a data structure (i.e., an abstraction) does not fall within any statutory category. *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994). Significantly, “[a]bstract software code is an idea without physical embodiment.” *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 449 (2007).

The unpatentability of abstract ideas was reaffirmed by the U.S. Supreme Court in *Bilski v. Kappos*, No. 08-964, 2010 WL 2555192 (June 28, 2010).

With this background in mind, all claims on appeal, claims 1 through 27, are rejected under 35 USC § 101 as being directed to nonstatutory subject matter. Consistent with our earlier-noted invention statement taken from Appellants' disclosed abstract, the disclosed and claimed invention is directed to software per se, abstract ideas, abstract concepts and methodologies, and the like, including various data structures, software, software applications, and abstract intellectual processes associated with them within the claims on appeal.

Appellants' disclosed abstract itself states that an "apparatus" comprises an event monitor, a usage processor, and usage indicator which are stated to be implemented as computer instructions, including as a single computer program. This analysis is consistent with the subject matter at Specification page 5 that indicates various identified elements have expansive rather than defined meanings in the art. Again, the claimed event monitor, usage processor, and usage indicator are stated at Specification page 5 to be implemented as computer instructions. The functionalities associated with these identified terms are illustrated in disclosed figures 3 and 5 in flowchart form. Significantly, the sentence bridging Specification pages 6 and 7 states that "[t]he present invention is a methodology that can be embodied in a computer program."

This brief analysis is clearly applicable to representative independent method claim 21 on appeal that is reproduced earlier in this opinion. The body of each independent claim 1, 11, and 21 recites essentially the same

functional features relating to the previously described event monitor, usage processor, and usage indicator. Much of the wherein clause at the end of these claims relates as well to human/user determinations/analyses. As indicated earlier in our analysis, the claimed apparatus in the preamble of independent claim 1 on appeal is not hardware but comprises, as defined in the abstract etc., software entities themselves. A computer program is directly recited in independent claim 11 and the computer readable storage medium of this claim presumptively includes transitory signal embodiments. The medium includes and encompasses signals per se, all of which are proscribed by the earlier-noted case law. Note also the analysis provided by *Subject Matter of Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010).

CONCLUSION and DECISION

We have *pro forma* vacated the outstanding rejection over applied prior art of all claims on appeal, claims 1-27. We have instituted a new ground of rejection within 37 C.F.R. § 41.50(b). This new rejection of all claims on appeal is based upon 35 U.S.C. § 101 since these claims are directed to non-statutory subject matter.

A new ground of rejection is pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that: “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise

one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197(b)) as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

(2) *Request rehearing.* Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

VACATED
37 C.F.R. § 41.50(b)

llw

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